



In re: Application of KOCH, Frank J.  
Serial No: 09/542,640 (Reissue of Patent 5,930,744)

**EXHIBIT A**

**PTO Form 1449 Listing of Patents, Publications, And  
Other Items of Information Relied Upon**



## EXHIBIT B

### Concise Explanation of the Relevance of Each Item Relied Upon and Listed in Exhibit A

***1. Copy of Third Party Observations filed in the U.K. Patent Office in connection with DeFelsko's U.K. application, citing various prior art documents.***

It is believed that this item is self-explanatory.

***2. Copy of Affidavit of Peter Baldwin dated January 19, 1998.***

This Affidavit was submitted concurrently with the foregoing Third Party Observations and included the prior art documents cited in the Third Party Observations. The prior art documents are attached to the Affidavit as Exhibits "A" through "O," which are discussed below, with reference to each of the Elcometer instruments to which they pertain.

### Documents Related to the Elcometer 300

The Elcometer 300 is an electronic coating thickness measuring instrument with an electronic memory for storing a plurality of coating thickness measurements, and an item of descriptive data associated with each measurement. The item of descriptive data can be the words high, low, base set or calibrated. See page 4 of the information sheet and page 13 of the operating instructions.

The first sale of an Elcometer 300 was made during the period April 1987 to March 1988.

- ***Exhibit "A" from Affidavit of Peter Baldwin, "Elcometer 300 Information Sheet."***

This information sheet describing the Elcometer 300 was first made publicly available during April of 1991.

**EXHIBIT "B" (contd.)**

- ***Exhibit "B" from Affidavit of Peter Baldwin, "Elcometer 300 Operating Instructions."***

These operating Instructions accompanied each Elcometer 300.

- ***Exhibit "C" in Affidavit of Peter Baldwin, "Elcometer 300 Specification Sheet."***

This specification sheet for the Elcometer 300 was first made publicly available during April of 1991.

**Documents related to the Elcometer 355**

The Elcometer 355 was first offered for sale to the public during September of 1994.

The first sale of an Elcometer 355 was made in December 1994.

- ***Exhibit "D" in Affidavit of Peter Baldwin, "Elcometer 355 Information Sheet."***

This information sheet for the Elcometer 355 was first made publicly available during September of 1994.

- ***Exhibit "E" in Affidavit of Peter Baldwin, "Elcometer 355 Instruction Booklet."***

This instruction booklet for the Elcometer 355 was first made publicly available during September of 1994.

- ***Exhibit "F" in Affidavit of Peter Baldwin, "Printout from an Elcometer 355 Coating Thickness Gauge."***

This printout shows use of the Elcometer 355 with printing capabilities as of January 24, 1995.

**EXHIBIT "B" (contd.)**

- ***Exhibit "G" in Affidavit of Peter Baldwin, "Printout from an Elcometer 355 Coating Thickness Gauge in Histogram Format."***

This printout shows use of the Elcometer 355 with graphing capabilities as of January 24, 1995.

- ***Exhibit "H" in Affidavit of Peter Baldwin, "Copy of Invoice No. 029902 issued by Elcometer Instruments Limited."***

The invoice shows the sale of an Elcometer 355 Demonstration kit including a thickness gauge on November 17, 1994.

**Documents related to the Elcometer 365**

- ***Exhibit "I" in Affidavit of Peter Baldwin, "Elcometer 365 Information Sheet."***

This information sheet was first made publicly available at the Elcometer Distributor Conference held between July 4-6th, 1994 at Cottons Hotel, Knutsford, England.

Copies were handed on a non-confidential basis to distributors of Elcometer products who were invited to the conference. The distributors were subsequently at liberty to disclose the information to members of the public.

The booklet discloses an electronic coating thickness gauge with a memory for storing a plurality of coating thickness values and which is capable of displaying a representation of a product for which measurements are to be taken (page 4). A representation of a product can be used as a descriptor of coating thickness data (last page).

- ***Exhibit "J" in Affidavit of Peter Baldwin, "Elcometer 1994 World Sales Conference program."***

This program was distributed at the conference.

**EXHIBIT "B" (contd.)**

- ***Exhibit "K" in Affidavit of Peter Baldwin, "Elcometer 365 Information Sheet."***

This information sheet was available to members of the public on a non-confidential basis to visitors to The Quality Show, U.S.A., which was an exhibition held between April 24-26, 1995.

- ***Exhibit "L" in Affidavit of Peter Baldwin, "Elcometer Lead Sheet"***

This lead sheet documents a request for information from Peter Wright of Alternate Systems in Texas, for the Elcometer 365 as of April 28, 1995

- ***Exhibit "M" in Affidavit of Peter Baldwin, "Dataputer Specification Sheet."***

Copies of this Sheet were made available to the public during April 1990.

These instruments were first offered for sale to the public during April 1990.

- ***Exhibit "N" in Affidavit of Peter Baldwin, "Copy of Invoice No. 016849 issued by Elcometer Instruments Limited," dated July 14, 1993.***

The invoice shows the sale of a Dataputer to Zinc Alloy Limited on July 14, 1993.

- ***Exhibit "O" in Affidavit of Peter Baldwin, "Fischerscope MMS Information Sheet."***

This information sheet was first made publicly available during February 1994.

These instruments were believed to be first offered for sale to the public during February 1994.

**EXHIBIT "B" (contd.)**

The Fischerscope MMS system is an electronic coating thickness measuring gauge which includes a probe electrically connected to a memory capable of storing up to 20,000 measurements. As described in the first paragraph on the reverse of the information sheet a facility is provided to allow alpha numeric data to be entered into the memory to identify measured thickness values.

***3. Comments made by Examiner in response to Third Party Observations submitted in DeFelsko's U.K. application.***

DeFelsko's U.K. application was terminated before grant as a result of DeFelsko's failure to respond to the objections raised by the U.K. patent office, which were based on the Third Party Observations submitted by Elcometer.

***4. Copy of Initialed PTO Form 1449 dated December 16, 1998 from File History of U.S. Patent No. 5,930,744.***

Each of the items listed on the Form 1449 were considered by the U.S. Patent Office, as evidenced by the initials of the Examiner. However, the Form 1449 lists selected submissions of those referred to in the Third Party Submissions and referred to in the Affidavit of Peter Baldwin dated January 19, 1998.

***5. Copy of Correspondence from Wilson, Gunn, M'Caw to DeFelsko's U.S. attorneys, dated May 14, 1999.***

It is believed the letter is self-explanatory.

**EXHIBIT "B" (contd.)**

***6. Copy of Correspondence from Wilson, Gunn, M'Caw to DeFelsko's U.S. attorneys, dated May 20, 1999, and copies of the two (2) enclosures.***

- ***Enclosure (1) - Elcometer 500 literature (dated June 1986); Elcometer 500 Instruction Manual; and Instruction Sheets relating to the use of coating thickness measuring probes with the Elcometer 500 (dated July 3, 1987).***

The Elcometer 500 instrument can be electrically connected to a coating thickness measuring probe. When used in this way the instrument functions as a coating thickness measuring instrument with a facility to statistically analyze collected data - see pages 2 and 7 of the information sheet, section 3.1.2.4 of the instruction manual and the additional instruction sheets which refer to connecting the instrument to a coating thickness module. The module comprises a coating thickness probe connected to an electronic interface designed for connection to the instrument.

The instrument allows descriptive alpha numeric data to be entered to describe coating thickness data. The instrument may also be programmed to prompt the user when taking measurements. See page 4 of the information sheet and sections 2 (under the heading "Data") and 3.3 of the instruction manual. A visual representation of this feature is given on page 4 of the literature in the form of a table. In the case where only one reading is taken for each feature each reading has an associated item of descriptive data.

The instrument enables statistical analysis and graphical representation of collected data. See page 5 of the literature and sections 1.5, 2 (particularly under the heading "Report") and 3.3.6 onwards of the instruction manual.

The instrument is capable of downloading information to a computer for further processing. At page 6 of the literature the Datastat program is referred to.

**EXHIBIT "B" (contd.)**

- ***Enclosure (2) - Introductory Pages and Chapter 1-6 of the SPC FocusPlus Users Manual produced by VERAX Systems, Inc.; and Extracts from an Addendum to the VERAX SPC FocusPlus users manual.***

The function of the SPC FocusPLUS software is to analyze measurement data and is summarized in chapter 1 of the manual. In particular, a computer running the software may be linked to an appropriate piece of apparatus, for example a coating thickness measuring probe, so that data may be acquired directly. A development to the software is described in the Addendum which was published in 1993 and in chapter 6 of the manual which was introduced in 1994. The development is the ability of the software to display CAD (computer aided design) drawings during data entry to guide the user. See in particular section 6.3.4 of the manual and enclosed extract from the Addendum.

***7. Copy of Unsigned PTO Form 1449 from File History of U.S. Patent No. 5,930,744.***

The Form 1449 lists the items included in correspondence from Wilson, Gunn, M'Caw to DeFelsko's U.S. attorneys, dated May 20, 1999.

The IDS and 1449 form were made of record in the File History. However, none of the items listed on the Form 1449 were considered by the U.S. Patent Office, as evidenced by the lack of initials by the Examiner.



**EXHIBIT "B" (contd.)**

***8. Copy of New Affidavit of Peter Baldwin dated August 1, 2001 and referring to prior art documents attached thereto as Exhibits "A" through "Q."***

Exhibits A-N of the Affidavit of Peter Baldwin dated August 1, 2001 are the same as those listed in the Affidavit of Peter Baldwin dated January 19, 1998. The foregoing description of each reference is incorporated herein by reference.

Exhibit "O" in Affidavit of Peter Baldwin dated August 1, 2001 is the same as enclosure one (1) in the Correspondence from Wilson, Gunn, M'Caw to DeFelsko's U.S. attorneys, dated May 20, 1999. The foregoing description of the reference is incorporated herein by reference.

Exhibit "P" in Affidavit of Peter Baldwin dated August 1, 2001 is the same as enclosure one (2) in the Correspondence from Wilson, Gunn, M'Caw to DeFelsko's U.S. attorneys, dated May 20, 1999. The foregoing description of the references is incorporated herein by reference.

Exhibit Q of the Affidavit of Peter Baldwin dated August 1, 2001 is the same as Exhibit O of the Affidavit of Peter Baldwin dated January 19, 1998. The foregoing description of the reference is incorporated herein by reference.

***9. Copy of Instruction Manual for an ETG instrument, available in the U.S. since 1991.***

On page 2 of the manual, there is an illustration of a diagram of an automobile indicated where a coating thickness reading should be taken and in what sequence. The image is displayed by the instrument during use.

***10. Copy of representative MG Rover data recordal sheet***

The MG rover data sheet illustrates a typical representation of points on a vehicle arranged so that the coating thickness values taken are recorded on the sheet in association with the point in which the vehicle from which they were taken. It is believed that this system has been in use since prior to 1994.

**EXHIBIT C**

**Copies of Patents, Publications, and Other Items of Information Relied upon**